

II. REMARKS

1. Applicant appreciates the Examiner's acknowledgement that "obviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." However, the Examiner has failed to demonstrate where, in either one of the cited references, such "teaching, suggestion or motivation" is illustrated. When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference." In re Rijkaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to do so here.

Gerszberg deals with a subscriber service where the subscriber can order or request additional information on products that are being advertised. (Abstract). Although Gerszberg discloses that a user may select from any number of the advertised services on the video phone and/or other user interface such as a cable set-top box, these services do not include and are not even remotely suggestive of "printing postal indicia" as is claimed by Applicant. Applicant is not dealing with advertising postal services for selection by a user.

Gerszberg is limited to soliciting services from commercials and advertisements (Col. 8, lines 16-66). Gerszberg does not even remotely suggest printing postal indicia, or cryptographically secure indicia. Rather Gerszberg is directed to a system offering interactive advertisement services. (Col. 10, lines 39-10). Gerszberg certainly does not disclose or suggest that a

host includes a postal security device with a secure housing, cryptographic means or a non volatile memory having an accounting register indicative of postage value as recited in Claim 1.

The Examiner proposes to combine Gerszberg with Moore. However, there is nothing in Gerszberg to suggest that it would lend itself to producing postal indicia using a postal security device. Producing postal indicia is not at all related to advertising or marketing of services, which is the focus of Gerszberg. Furthermore, there is nothing in Moore to suggest that its system for dispensing, verifying and tracking postage or other information or mail pieces can be accomplished via a television medium or set-top box.

Although the Examiner is correct that a "customer" in Moore can be a PC-based home office, the Examiner should closely note the use of the term "PC-based". There is not even a remote suggestion of a customer ordering postal indicia via a television set-top box as recited by Applicant in the claims. Furthermore, although Moore states that there are 1.5 million postage meters in use, made by several vendors, none of these postage meters are described as operating communicatively with or through a television set-top box. The Examiner should read just a few lines down from the above portion of Col. 1, which states in pertinent part that "a secure postal metering system which requires input from the user, the vendor, and the postal service has heretofore not been available." (Col. 1, lines 65-67). The mere fact that there may be 1.5 million postage meters in use does not provide any motivation to combine Moore with Gerszberg to achieve Applicant's invention, and does not in any way disclose Applicant's invention as recited in the claims.

That each host computer in Moore cooperates with the control computer through a postal security device does not provide the motivation to combine Moore with Gerszberg. There is no suggestion here of using a television set-top box to produce postal indicia or that postal indicia would somehow be advertised services. Moore is limited to tracking a postal item within the mail system, and does not disclose or suggest anything even remotely related to advertising, marketing or ordering services over a television service.

Thus, there is no motivation in either of the references to combine Gerszberg and Moore as suggested.

Furthermore, references can only be combined under 35 U.S.C. §103(a) if the references are analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the Applicant's, or
- 2) The reference is reasonable pertinent to the particular problem with which the Applicant was concerned.

Applicant's invention is directed to being able to print postal indicia, via a postal security device, using a television set-top box. Gerszberg is limited to allowing a user to interact with services that are advertised or marketed over television broadcast. Applicant's invention is directed to printing postal indicia and not selecting services that are advertised over a television. Moore is a system for printing and tracking postal indicia and does not even remotely suggest using a television

set-top box to obtain and print the indicia. Although Applicant's invention is directed to printing postal indicia, the communication medium is the television set-top box. Nothing in Moore even remotely suggests this feature of Applicant's invention. Thus, Gerszberg and Moore may not be properly combined for the purposes of 35 U.S.C. §103(a).

2. Even if combinable, the combination of Moore in view of Gerszberg does not disclose or suggest Claims 1-5, 7, 10, 11, 15 and 17 under 35 U.S.C. §103(a).

Claim 1 recites that the host comprises a PSD, not the customer station. Moore clearly illustrates that a PSD 400 is associated with each customer 14. (See at least FIG. 1). This is one distinct difference.

Moore also does not disclose or suggest means responsive to information provided by the customer at the remote control at one of said customer station for sending to the host a first message requesting a postal indicium as claimed by Applicants. Rather in Moore the "control computer 12 contacts the host computer 14 and enables a specific number of imprints or, alternately, to distribute a specific amount of postal fee." (Col. 11, lines 45-48, see also Col. 12, lines 55-56) There is no provision or disclosure in Moore of a customer using a remote control to enter information and request indicia from the host as is claimed by Applicants. In Moore, the host computer 14 stores the selected, customer specific information. Thus, Moore does not disclose Applicants' invention.

Furthermore, in Applicants' invention the cryptographic means are located in the postal security device which is located at

the host. In Moore, a postal security device is located at each customer station, not at the host as in Applicants' invention. Gerszberg does not disclose or suggest cryptographic means. Thus, Moore in view of Gerszberg cannot disclose or suggest Applicants' invention.

In Applicant's invention, the "accounting means" indicate "postage value printed" at each customer station. The "accounting means" in Moore merely "tracks the number of marks allotted to the host computer." (Col. 13, lines 64-67, emphasis added). This is clearly not the same as indicating "postage value" printed at each station, since postage value can vary and is not dependent on the allotment, particularly where in Applicant's invention, the dispensing of postage is not a function of an "allotment", unlike Moore. So Moore does not disclose or suggest an "accounting means" as is claimed by Applicant.

It would not be obvious to modify Moore as taught by Gerszberg to have a customer request postal indicia to have the correct amount of postage applied to mail. Nowhere does Gerszberg suggest that a user could "call up" a specific service. Rather, the user must react to a service being advertised at the moment. Thus, there is no motivation to combine the references in this regard.

Therefore, in light of the foregoing, it is respectfully submitted that Claims 1-4 are not disclosed or suggested by Moore in view of Gerszberg. Claims 5-17 depend from Claim 1, and should also be allowable at least in view of the dependencies, since the combination of Moore and Gerszberg does

not disclose or suggest each of the features of the independent claims from which each depends.

3. Further, Claim 6 is not unpatentable over Moore in view of Gerszberg in view of Bush. Moore and Gerszberg are not combinable and even so, do not disclose or suggest Applicant's invention as claimed. Bush does not overcome the aforementioned deficiencies. Bush allows a user to call up a menu to pay for a product or service. This is not the same as a postage submenu related to postage or the entry of identification data associated with a request for postal indicia.

4. With respect to Claim 8, Ryan, Jr. is not proper or effective prior art against Applicant's invention. Applicant's invention has a priority date of January 30, 1998, which precedes the filing date of Ryan, Jr. Ryan, Jr. was filed on December 30, 1998. Therefore, Claim 8 should be allowable.

5. Claim 9 is not disclosed or suggested by Moore in view of Gerszberg in view of Reisinger. Reisinger does not overcome the aforementioned deficiencies of Moore and Gerszberg.

Claim 9 does not recite a weight scale coupled to the postage indicia device as suggested by the Examiner. Rather, claim 9 recites a "weighing scale communicatively coupled to the set-top box." This is not disclosed or suggested by Reisinger.

6. With regard to Claim 12, Merjanian is not an effective prior art reference against Applicant's invention. Merjanian was filed on February 10, 1999. Applicant's priority date is January 30, 1998, before Merjanian.

7. With regard to the rejection of Claims 13, 14 and 16, the Expedia reference is not a proper or effective reference against Applicant's invention. Applicant's priority date is January 30, 1998. Based on the information provided by the Examiner, the earliest date of a portion of the Expedia reference is July 11, 1998 (page 8 of 18), which is after Applicant's priority date. Thus, Claims 13, 14 and 16 are allowable.

8. Claims 18-20 are not disclosed by Moore in view of Gerszberg in further view of Schwartz, Brookner and Expedia.

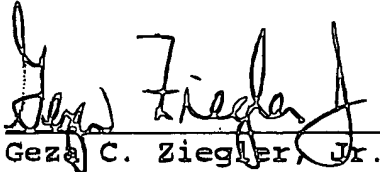
As noted above, Expedia is not a proper or effective reference against Applicant's invention for purposes of 35 U.S.C. §103(a) since its effective date is after Applicant's earliest effective priority date.

Furthermore, the lumping together of a number of references does not eliminate the obvious fact that Moore in view of Gerszberg does not disclose or suggest each element of Claims 18 and 20, for the reasons stated earlier. Schwartz, Brookner and Expedia do not overcome the deficiencies noted with respect to Moore and Gerszberg. Claim 19 should be allowable at least in view of its dependency.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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